



AF/IFW  
\$

PTO/SB/21 (09-04)  
Approved for use through 07/31/2006. OMB 0651-0031  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	10/613,946	
	Filing Date	07/07/2003	
	First Named Inventor	Kevin T. Connelly	
	Art Unit	3616	
	Examiner Name	Winnie S. Yip	
Total Number of Pages in This Submission	8	Attorney Docket Number	

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement  <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers  <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC  <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
<b>Remarks</b>  Brief on Appeal		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm Name	Apollo Sunguard		
Signature			
Printed name	Werner H. Schroeder		
Date	07/18/06	Reg. No.	36,387

CERTIFICATE OF TRANSMISSION/MAILING			
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:			
Signature			
Typed or printed name		Date	

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



Under the Paperwork Reduction Act of 1995 no persons are required to respond to a collection of information unless it displays a valid OMB control number

Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

# FEE TRANSMITTAL For FY 2006

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 250.00

## Complete if Known

Application Number	10/613,946
Filing Date	07/07/2003
First Named Inventor	Kevin T. Connolly
Examiner Name	Winnie S. Yip
Art Unit	3616
Attorney Docket No.	

## METHOD OF PAYMENT (check all that apply)

☒ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): \_\_\_\_\_

☐ Deposit Account: Deposit Account Number: \_\_\_\_\_ Deposit Account Name: \_\_\_\_\_

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee

☐ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☐ Credit any overpayments

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

## FEE CALCULATION (All the fees below are due upon filing or may be subject to a surcharge.)

### 1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

### 2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

<u>Total Claims</u>	<u>Extra Claims</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>	<u>Multiple Dependent Claims</u>	
- 20 or HP = _____	x _____	= _____		<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>

HP = highest number of total claims paid for, if greater than 20.

<u>Indep. Claims</u>	<u>Extra Claims</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>
- 3 or HP = _____	x _____	= _____	

HP = highest number of independent claims paid for, if greater than 3.

### 3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

<u>Total Sheets</u>	<u>Extra Sheets</u>	<u>Number of each additional 50 or fraction thereof</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>
- 100 = _____	/ 50 = _____	(round up to a whole number) x _____	= _____	

### 4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): \_\_\_\_\_ Brief on Appeal \_\_\_\_\_ Fees Paid (\$) 250.00

### SUBMITTED BY

Signature	<i>Werner H. Schroeder</i>	Registration No. (Attorney/Agent)	36,387	Telephone	(239) 592-5843
Name (Print/Type)	Werner H. Schroeder	Date	07/18/06		

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



## Brief on Appeal

Application No. 10/613,946

The specific items required by 37 CFR 1,192(c) follow below:

### Real Party of Interest

The real Party of interest in this application is the Inventor **Kevin T. Connelly**

### Related Appeals and Interferences

There are no related Appeals and Interferences

### (1) Status of the Claims

Claims 1, 4, and 9 - 11 and 16 are presently prosecuted in this application and are under a Final rejection.

Claims 2, 3, 5 - 8 and 12 - 15 are withdrawn subject to a restriction requirement

The examiner made a mistake by indicating on the cover sheet PTOL 326 that claim 16 is withdrawn while in fact claim 16 is pending in this application but the examiner refused to consider it in Par. 3 of the final rejection.

07/28/2006 BABRAHA1 00000069 10613946

01 FC:2402

250.00 OP

### (2) Status of Amendments

a) A Final Rejection was mailed on 06/08/2006.

b) Applicant answered the Final Rejection by way of remarks and arguments on 06/16/2006

c) The examiner responded to applicant's arguments by way of an Advisory Action which was mailed on 06/26/2006. The examiner answered by stating "that the arguments were not deemed persuasive to make the claimed invention overcome the prior art of record and place the application in condition for allowance."

### (3) Summary of the Invention

The Appellant's invention pertains to a shade and rain umbrella combination. The basic umbrella consists of having the conventional shaft and expanding ribs at a top of the shaft. A shade cover is placed over the ribs and is fastened to the peripheral points of the ribs. The shade cover consists of a woven mesh fabric for protection against ultraviolet rays of the sun. However the mesh fabric allows for a ventilation by air being able to pass through the mesh of the shade cover. This umbrella appears in many instances in sun-backed areas to protect against the UV rays of the sun. In case of rain a water proof cover may immediately be placed over the shade cover. the rain cover may be placed over the shade cover by way of fastening the peripheral points of the rain cover to points of the ribs. The rain cover has substantially the same size as the shade cover and is stored somewhere on the umbrella shaft when not in use.

### Issues

Claims 1 and 4 are rejected under 35 U.S.C 103(a) as being unpatentable over Johnson at el US Patent No, 5,487,401 in view of Bilotti US Patent No. 5,678,587 and in view of Kupferman US Patent No. 5,890,506. The examiner has to apply three references to make this rejection.

Claims 9 -11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson '401 in view of Kupferman '506 and Bilotti '587 as applied to claim 1 above and further n view of Allee US Patent No. 6,378,539. The examiner has to apply four references to make this rejection. The examiner was challenged in previous actions in the use of multiple references and she answered with a citation of *In re Gorman* , 933 F. 2d 982, USPQ 2d 1855 (Fed. Cir.1991). It may be that the references are in the same umbrella art but the cited references are quite different from what is claimed.

### Grouping of claims

Claims 1, 4, 9 - 11 and 16 stand or fall together.

### Argument

The rejection of claims 1 and 4 cannot stand because the reference to Johnson is an entire different concept and construction. The reference to Johnson does not disclose the concept of a two mode use of an umbrella as is claimed by appellant, that is the use of sun shade umbrella and in a second mode the use as a rain umbrella. Johnson discloses a windproof umbrella that only be used in one mode and that is if the umbrella, while in use, is subjected to high winds it is resistant to an inversion from high winds. This is the only purpose of the Johnson umbrella. The disclosed umbrella has a post to be grasped by a user and a plurality of ribs extending outwardly in a radial direction. A lower canopy is secured in a covering relation on the ribs. The lower canopy or cover includes a plurality of vent holes there through and a channel forming member secured to the lower canopy in surrounding relation to each lower vent hole. If this umbrella, so far described, would be used as a shade cover, as is claimed, it would be totally useless because of the vent holes 34 therein.

However, Johnson provides an additional stationary cover over the lower cover which may be fastened to the peripheral points of the ribs. In the Abstract it is expressly stated that the upper canopy has a dimension less than the lower canopy. This is contrary to what Appellant is claiming in claim 1. In addition, the upper canopy has openings 44 therein to let winds to pass there through.

The examiner states that "Johnson has a shade cover 20 over and supported by the ribs 18". The examiner continues to state that "the shade cover is made of a water resistant material with openings for allowing ventilation to pass there through". This

is an incorrect interpretation of the Johnson reference. If the rain cover is made of water proof material and there are openings therein, it is not a rain proof cover at all.


The examiner continues to state "that the rain cover 36 is placed over and connected to the shade cover by fastening means". This is incorrect. Appellants rain cover is not fastened to the shade cover but is fastened to the peripheral points of the ribs. The examiner continues to state that "the rain cover 36 has a size that may be substantially the same as the shade cover. This is incorrect in that Johnson specifically states the upper canopy has a dimension less than that of the lower canopy (Abstract).

The examiner now introduces the Kupferman reference by admitting that the shade cover of Johnson is not defined as a fabric made of mesh material for protection against ultraviolet rays of the sun as is claimed. At this point in the discussion the Appellant wants to point out that at no time in the disclosure of Johnson there is any talk of a shade and a rain cover. The examiner derives these words from appellants disclosure. The Examiner continues to state that "Kupferman teaches a shade and rain umbrella combination comprising a rain cover 24, disposed on the shade cover 22, wherein the shade cover 22 having at least a portion 32 being made of woven mesh fabric for allowing ventilation air to pass there through and the rain cover 24 covering the mesh portion for preventing the rain into the mesh portion when used in raining". The examiner misinterprets this reference. There is never a mention of a shade cover and a rain cover. This umbrella is only used when it is raining and is designed to prevent an inversion of the umbrella in high winds just the same as the base reference to Johnson. The Examiner now suggests to modify the Johnson umbrella by incorporating the mesh fabric of Kupferman at least partially over into the shade cover 20 of Johnson. It is believed that the Johnson umbrella cannot be modified in this manner, as is suggested by the Examiner. It is believed that this proposed modification would destroy the basic function and concept of the Johnson

umbrella. This proposal is no indicia of obviousness and should not be made in rejection claims.

The examiner now introduces the Bilotti reference to modify the Kupferman reference to provide the portion of the mesh material with a coat to prevent ultraviolet rays from the sun to the person carrying the umbrella. There is no need to make this modification because both umbrellas of Johnson and Bilotti do not use their umbrellas in a two mode fashion as is claimed by Appellant. They are simply rain umbrellas to prevent high winds from inverting the umbrellas. Since they are not used as shade umbrellas, there is no use to convert any of them to protect against ultraviolet rays from the sun. None of the references to Johnson or Bilotti disclose that the rain covers may be kept separate, as is claimed in claim 1. None of their reference disclose a dual mode of use and that is, the use as a shade umbrella and the use as rain umbrella by using two different covers, as is claimed.

In view of all of the above, the Board of Appeals is respectfully requested to reverse the Examiner in the finally rejected claims.

  
Werner H. Schroeder

Reg. No, 36,387

Date: 07/18/06

## Appendix

1. A shade and rain umbrella combination including a basic umbrella having a shaft and expanding ribs at a top of said shaft, a shade cover placed over said ribs and fastened to a peripheral point at the end of said ribs, said shade cover consisting of a woven mesh fabric for protection against ultraviolet rays of the sun but at the same time allowing ventilation air to pass through said fabric, a separable water proof rain cover is placed over said shade cover in the event of rain, said rain cover is substantially the same size as said shade cover, means for fastening said rain cover to said peripheral point at each of the ends of said ribs, whereby said shade is used in sunshine and said rain cover is added in the event of rain but separate otherwise.

4. The umbrella combination of claim 1, wherein said means for fastening are flexible eyelets on said rain cover placed over each point at each end of said ribs.

9. The umbrella combination of claim 1 including means for clamping said shaft in an upright position on an object.

10. The umbrella combination of claim 9, wherein said means for clamping has a form of a C-shape clamp.

11. The umbrella combination of claim 10, wherein said C-shape clamp has means thereon for orienting and clamping said C-shape clamp in two different directions.

16. The umbrella combination of claim 1, wherein said shade cover is constructed of a knitted fabric including HDPE Polyethylene mono-tape.